



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,571	10/17/2001	Motoki Kato	450100-4886.1	7985

20999 7590 05/19/2003

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER

YOUNG, WAYNE R

ART UNIT	PAPER NUMBER
----------	--------------

2655

DATE MAILED: 05/19/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/982,571

Applicant(s)

KATO, MOTOKI

Examiner

W. R. Young

Art Unit

2655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 07 March 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09313100.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

Art Unit: 2655

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 3/7/02 have been approved by the examiner. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

New formal drawings are required in response to this office action.

2. Applicant's arguments filed 12/20/02 have been fully considered but they are not persuasive.

Applicant argues that the new claims are allowable because they include limitations the Examiner allowed in parent case 09/313,100. First, it is noted that the limitations now claimed are not as specific as those previously allowed by the examiner. Thus, the argument as to patentability is not convincing. Second, the claims in case 09/313,100 were drawn to a reproducing apparatus as shown in figure 12, whereas the claims elected for prosecution in this case in response to the Restriction requirement were drawn to a recording apparatus as shown in figure 7. Applicant should note that filing an RCE merely removed the Finality of the last office action and not the election. The election of the recording apparatus carries forward. Inasmuch as applicant intended to claim the reproducing apparatus, all the current claims would be considered to be clearly drawn to a non-elected invention and the amendment of 12/20/02 held as non-responsive to the previous office action. Inasmuch as applicant intended to claim a combination recording/reproducing apparatus, the current claims as evidenced by at least claim 22 are patentably distinct from the elected recording apparatus that required extracting means and clock generating means not required by the combination evidence claim 22 and the parent 09/313,100 case reproducing apparatus which required additional patentable limitations noted,

Art Unit: 2655

supra. The subcombinations each have separate utility with servo control or camera apparatus. Thus, all the current claims would be considered to be clearly drawn to a non-elected invention and the amendment of 12/20/02 held as non-responsive to the previous office action. Inasmuch as applicant is arguing patentability based on the record of the 09/313,100 case, the current claims should be amended to actually recite the same allowable language as that of the parent case, to recite the recording apparatus as originally elected so as not to be drawn to a patentably distinct invention therefrom, and a Terminal Disclaimer filed. Inasmuch as the claims could be interpreted as still claiming a recording apparatus as originally elected, the following action is made.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 18-43 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention and/or are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 (other claims recite similar language) recites extractor, clock generator, arrival time-stamp generator, formatting unit, and information generator, all drawn to the recording

Art Unit: 2655

apparatus shown in figure 7. Claim 18 (other claims recite similar language) also recites a “controller operable to control the output of said transport packet on the basis of the information and the arrival time stamp” which is not found in the recording apparatus of figure 7. It appears that this feature may read on the reproduction apparatus shown in figure 12. Dependent claims 19-20 (other dependent claims recite similar language) recite a playback management file not found in figure 7, but which may be in reproducing apparatus figure 14. Dependent claim 21 (other dependent claims recite similar language) recites a playback control circuit not found in figure 7, but which may be in reproducing apparatus figure 19. Thus, the claims are either not adequately disclosed or are misdescriptive of what is disclosed and therefore indefinite.

5. Claim 43 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim is incomplete and thus indefinite as the preamble recites “A recording medium for storing a plurality of connected data streams . . . being stored in accordance with the following steps” and none of the steps refer to “storing”.

6. In light of the § 112 rejections above, the following prior art rejections are made to the claims as best interpreted by the examiner.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 43 is rejected under 35 U.S.C. 102(b) as being anticipated by Adachi et al.

Art Unit: 2655

Claim 43 is directed to a recording medium written in product by process format. No storing step is claimed or referenced by any of the process steps; hence the claimed recording medium is met by Adachi et al. which clearly discloses a recording medium for storing information, i.e., data streams. See the front cover.

9. A search has been made to find the most pertinent art, but no statement will be made in this office action regarding the allowability of the claims, due to the speculation required to interpret the claims because of their indefiniteness under 35 U.S.C. 112, 1st and 2nd paragraphs as noted above (see In re Steele, 134 USPQ 292).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to W. R. Young whose telephone and VoiceMail number is (703) 308-1554. If a plurality of attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doris To, can be reached on (703) 305-4827.

The appropriate fax phone number for the organization (Group 2650) where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700 or the Group Customer Service section whose telephone number is (703) 306-0377.



WAYNE R. YOUNG
PRIMARY EXAMINER
ART UNIT 2655

wry/wry
5/5/03